

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 11, 2004. In order to advance prosecution of this case, Applicant amends Claims 1, 77, 101, and 155. The amendments are not made as the result of any prior art reference and do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already presented. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 101 Rejections

The Examiner rejects Claims 1-38, 77-127, and 155-168 under 35 U.S.C. §101: asserting that the claimed invention is directed to non-statutory subject matter. Although Applicant believes Claims 1-38, 77-127, and 155-168 recite allowable subject matter as written, Applicant has made clarifying amendments to Independent Claims 1, 77, 101, and 155 in order to address the Examiner's concern. In no way should such amendments be construed as acquiescence to the Examiner's contentions regarding these Independent Claims.

Applicant also respectfully reminds the Examiner of the standards and the jurisprudence associated with 35 U.S.C. §101. Patentable subject matter is clearly defined as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto."¹ When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. §101.² While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. §101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies the criteria of 35 U.S.C. §101.³ Thus, producing a useful, concrete, and tangible result is the key to patentability according to well established Federal Circuit rulings and other applicable case law.

¹ See 35 U.S.C. §101.

² See *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q. 2d 1545, 1558 (Fed. Cir. 1994); see also *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998).

³ See *AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding §101 and announced more expansive principles formulated with computer technology in mind); see also *In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356).

Amended Independent Claims 1, 77, 101, and 155 produce a useful, concrete, and tangible result and, therefore, are in full accordance with jurisprudence germane to this subject matter. Only in cases where a claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. §101.⁴ Thus, the Examiner's contention is mistaken, as Independent Claims 1, 77, 101, and 155 are not merely "directed to abstract ideas and, therefore, non-statutory subject matter."⁵ Instead, Independent Claims 1, 77, 101, and 155 are directed to various methods of routing an object in a transportation network that include a number of limitations, which are clearly within the scope of patentable subject matter as defined by 35 U.S.C. §101. Routing of an object in a transportation network provides just one of a myriad of practical applications of Independent Claims 1, 77, 101, and 155. Therefore, the rejection of Independent Claims 1, 77, 101, and 155 under 35 U.S.C. §101 is improper.

Accordingly, these identified Independent Claims are allowable. Additionally, the dependent claims corresponding to these Independent Claims are also allowable for analogous reasons.

Allowable Subject Matter

Applicant notes with appreciation the Examiner's allowance of Claims 39-76 and 128-154. Applicant reserves the right to comment on the reasons for the allowance of these claims at a future time should Applicant deem it appropriate to do so.

Thus, all of the pending claims have been shown to be allowable, as they are patentable over the references of record and, further, in the context of 35 U.S.C. §101. Notice to this effect is respectfully requested in the form of a full allowance of these pending claims.

⁴ See M.P.E.P. §2106.

⁵ See Previous and Current Office Action.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant believes no fees are due. If this is not correct, the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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